

APR 12 2002 TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.  
112703-017

In Re Application Of: Patel et al.

Serial No.	Filing Date	Examiner	Group Art Unit
09/648,033	August 25, 2000	A. Corbin	1761

Invention:

ENVIRONMENTALLY FRIENDLY CHEWING GUMS INCLUDING LECITHIN

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on February 6, 2002

The fee for filing this Appeal Brief is: \$320.00

- A check in the amount of the fee is enclosed.
- The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 02-1818  
A duplicate copy of this sheet is enclosed.

Signature

Dated:

April 8, 2002

RECEIVED  
APR 16 2002  
TC 1700

Robert M. Barrett (30,142)  
ATTORNEYS FOR APPLICANTS  
Bell, Boyd & Lloyd LLC  
P.O. Box 1135  
Chicago, Illinois 60690-1135

I certify that this document and fee is being deposited on 4/8/2002 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Renee Street

Typed or Printed Name of Person Mailing Correspondence

cc:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Patel et al.  
Appl. No.: 09/648,033  
Filed: August 25, 2000  
Title: ENVIRONMENTALLY FRIENDLY CHEWING GUMS INCLUDING  
LECITHIN  
Art Unit: 1761  
Examiner: A. Corbin  
Docket No.: 112703-017

Assistant Commissioner for Patents  
Washington, DC 20231

**APPELLANTS' APPEAL BRIEF**

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed on February 6, 2002 in the above-identified patent application.

I. **REAL PARTY IN INTEREST**

The real party in interest for the above-identified patent application on appeal is Wm. Wrigley Jr. Company by virtue of an Assignment dated August 25, 2000 and recorded in the United States Patent and Trademark Office.

II. **RELATED APPEALS AND INTERFERENCES**

Appellants do not believe there are any known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

### III. STATUS OF THE CLAIMS

Claims 1-20 are pending in this Application. A copy of appealed Claims 1-20 is attached hereto as the Appendix. In an Advisory Action dated January 18, 2002, Claims 1-20 are rejected. The Advisory Action refers to the Final Office Action dated October 11, 2001 regarding the reasons for the rejections. As outlined in the Final Office Action, Claims 1-6 and 14-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,518,615 ("Cherukuri 615"), U.S. Patent No. 4,794,003 ("Cherukuri 003") or U.S. Patent No. 4,452,820 ("D'Amelia"); Claims 8-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cherukuri 615*, *Cherukuri 003* or *D'Amelia*; and Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cherukuri 615*, *Cherukuri 003* or *D'Amelia* in view of U.S. Patent No. 4,246,286 ("Klose").

Lastly, the Patent Office rejected Claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of co-pending U.S. Patent Application No. 09/648,028 in view of either *Cherukuri 615*, *Cherukuri 003* or *D'Amelia*. Copies of the Advisory Action and the Final Office Action are appended hereto as Exhibits A and B, respectively, of the Supplemental Appendix, and a copy of the cited references are located in the Supplemental Appendix as Exhibits C-F.

### IV. STATUS OF THE AMENDMENTS

On December 11, 2001, Appellants filed an Amendment After Final wherein Appellants amended the patent application to overcome a pending rejection based on 35 U.S.C. § 112; wherein Appellants argued that Claims 1-6 and 14-20 are not anticipated under 35 U.S.C. § 102(b); wherein Appellants maintained that Claims 7 and 8-13 are not obvious under 35 U.S.C. § 103(a); and

wherein Appellants stated that Appellants will file a suitable Terminal Disclaimer upon notice of allowable subject matter in either one of the co-pending applications.

On January 18, 2002, the Patent Office issued and Advisory Action wherein the Patent Office entered Appellants' December 11, 2001 Amendment, but maintained its rejection of the claims based on 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). The Advisory Action did not address the Appellants' previous assurances that a Terminal Disclaimer will be filed upon notice of allowable subject matter. For the record, Appellants hereby restate their previous assurances regarding same.

V. SUMMARY OF THE INVENTION

The summary of the invention on Appeal is provided as follows:

The present invention relates generally to chewing gums. More specifically, the present invention relates to chewing gum compositions, and methods for making same, that result in gum cuds having reduced adhesion when compared to typical chewing gum compositions.

Appellants have discovered how to produce chewing gums that if improperly disposed of have reduced adhesion to environmental surfaces such as wood, concrete, fabric, carpet, metal and other such surfaces.

In this regard, Appellants have found that chewing gums that include high levels of lecithin and that do not include filler in the gum base result in gum cuds that display such reduced adhesion properties. These fillers are inert organic powders such as calcium carbonate, magnesium carbonate, ground limestone, and silica type compounds such as magnesium and aluminum silicate, clay, alumina, talc, titanium dioxide, calcium phosphate and combinations thereof. The fillers can be removed from typical gum base formulations and replaced with other ingredients such as plasticizers

or elastomers. By adjusting the levels of plasticizers and elastomers, this will compensate for any change in texture, taste, and overall quality of the product. (Specification, page 4, lines 25-33, page 5, lines 1-3.)

Lecithin is a complex, naturally occurring mixture of phospholipids that most often is obtained from soybean oil. Phospholipids function as the surface-active portion of lecithin; this portion affords lecithin most of its functional properties. The addition of lecithin to the gum formulation allows for various substances (such as oil and water) in the gum matrix to more easily blend together. (Specification, page 5, lines 16-21.)

It has been found that by eliminating fillers from gum bases and adding high levels of lecithin, that the resultant chewing gum, when chewed, will produce gum cuds having reduced adhesion to environmental surfaces. It is believed that eliminating the fillers from the gum base prevents the fillers from mixing with the active elements of the gum base (e.g., polymers, softeners, and flavors) causing a decrease in gum cud removal times. The addition of lecithin, especially at high levels, is believed to act as a partitioning agent between high molecular weight materials. Due to the absence of filler materials, the polar ends of the lecithin molecules remain free while the non-polar ends of the lecithin molecules remain attached to the high molecular weight materials. This results in a solid, but looser matrix of gum components. This matrix affords improved removability from surfaces characteristic to the gum cud. (Specification, page 5, lines 4-15.)

As noted above, the inclusion of lecithin is an essential feature of the claimed invention. Lecithin therefore is to be added to the chewing gum formulation in an amount ranging from about 3.0% to about 15.0% by weight of the chewing gum formulation. Further, in an embodiment, the chewing gum may include about 5.0% to about 9.0% lecithin in the formulation. In a gum base

formulation, lecithin may comprise approximately 20% to about 50% lecithin and in an embodiment, approximately 30% to about 40% lecithin. (Specification, page 5, lines 22-27.)

A variety of different chewing gums can be created pursuant to the present invention, all of which will lack fillers but will include lecithin. (Specification, page 4, lines 25-26.) Such chewing gums can include sugar gums, sugarless gums, bubble gums, coated gums, and novelty gums. Such chewing gums can be formed in the shape of pellets, sticks, tabs, or chunks. A variety of different chewing gum formulations are possible. (Specification, page 5, lines 28-32.)

As disclosed in Appellants' Patent Application, Appellants have produced numerous inventive chewing gum compositions pursuant to the claimed invention. The inventive compositions that include lecithin but not fillers display reduced adhesion characteristics when compared to conventional gum formulations that include fillers and/or not lecithin. (Specification, pages 11-14).

## VI. ISSUES

The issues on Appeal are as follows:

1. Would the chewing gum as defined by Claims 1-6 and 14-20 be anticipated by *Cherukuri 615, Cherukuri 003* or *D'Amelia* under 35 U.S.C. § 102(b)
2. Would the gum base as defined by Claims 8-13 have been obvious at the time of the invention to one of ordinary skill in the art under 35 U.S.C. § 103(a) over *Cherukuri 615, Cherukuri 003* or *D'Amelia*?
3. Would the chewing gum as defined by Claim 7 have been obvious at the time of the invention to one of ordinary skill in the art under 35 U.S.C. § 103(a) over *Cherukuri 615, Cherukuri 003* or *D'Amelia* in view of *Klose*?

## VII. GROUPING OF THE CLAIMS

Appellants argue for the separate patentability of each of the independent claims separate and apart from each other as set forth in detail below pursuant to the requirements of 37 C.F.R. § 1.192(7), unless otherwise specified.

## VIII. ARGUMENT

### A. The Claimed Invention -- Independent Claims

On Appeal, there are four independent claims, that is, Claims 1, 8, 14, and 18. Independent Claims 1, 8, 14, and 18 provide as follows:

Independent Claim 1 recites a chewing gum that includes a water insoluble portion that contains no filler; a water soluble portion including a flavor; and approximately 3% to about 15% by weight lecithin.

Independent Claim 8 recites a gum base that includes an elastomer; at least 20% by weight lecithin; and no filler.

Independent Claim 14 recites a chewing gum that includes a water soluble portion including a flavor; a water insoluble gum base portion that does not include a filler; and at least 5% by weight lecithin.

Independent Claim 18 recites a method for producing chewing gum wherein a resultant gum cud that is produced has reduced adhesion to environmental surfaces as compared to a gum cud produced by typical chewing gum formulations comprising the steps of using a gum base to produce the chewing gum that does not include a filler and adding at least 3% by weight lecithin to the chewing gum.

B. The Rejections

Claims 1-6 and 14-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Cherukuri 615, Cherukuri 003* or *D'Amelia*.

Claims 8-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cherukuri 615, Cherukuri 003* or *D'Amelia*.

Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cherukuri 615, Cherukuri 003* or *D'Amelia* in view of *Klose*.

Appellants respectfully submit that the rejections of Claims 1-6 and 14-20 under 35 U.S.C. § 102 should be reversed based on the fact that the Patent Office has failed to establish a *prima facie* case of anticipation. The Patent Office relies on *Cherukuri 615, Cherukuri 003* or *D'Amelia* to support its anticipation rejection.

Appellants additionally contend that the Patent Office has improperly relied on *Cherukuri 615, Cherukuri 003* or *D'Amelia* to support its obviousness rejection of Claims 8-13 under 35 U.S.C. § 103(b). In this regard, the Patent Office has failed to establish a *prima facie* case of obviousness.

Lastly, Appellants maintain that the rejection of Claim 7 under 35 U.S.C. § 103(b) is improper as the Patent Office has failed to establish a *prima facie* case of obviousness. In its rejection, the Patent Office argues that Claim 7 would have been obvious to one skilled in the art over *Cherukuri 615, Cherukuri 003* or *D'Amelia* in view of *Klose*.

1. The Applicable Law

a. 35 U.S.C. § 102

“Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art ...” *Akzo NV v. U.S. International Trade Commission*, 1 U.S.P.Q. 2d 1241, 1245 (Fed. Cir. 1986). The Court of Appeals for the Federal Circuit has held that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” *Verdegaal Bros v. Union Oil of California*, 814 F.2d 628, 631 (Fed. Cir. 1988) (*emphasis added*). Additionally, “the identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

b. 35 U.S.C. § 103

The Court of Appeals for the Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundation facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness....Thus, each obviousness determination rests on its own facts.

*In re Mayne*, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). “The mere fact that the prior art may be modified in the manner suggested by the Examiner

does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071 at 1075. (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the standard under 35 U.S.C. § 103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1742 (Fed. Cir. 1990).

“If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

2. The Rejection of Claims 1-6 and 14-20 under 35 U.S.C. § 102(b)  
Should Be Reversed Because the Patent Office Has Failed to  
Overcome its *Prima Facie* Burden

---

The Patent Office has failed to overcome its *prima facie* burden with respect to the rejection of Claims 1-6 and 14-20 under 35 U.S.C. § 102(b). The Patent Office has improperly relied on *Cherukuri 615*, *Cherukuri 003* or *D'Amelia* to support its anticipation rejection. As noted above,

Appellants have surprisingly found that a reduced-adhesion chewing gum can be formulated by excluding fillers while including lecithin. In this regard, independent Claims 1 and 14 relate to a reduced-adhesion chewing gum that requires the simultaneous inclusion of lecithin and exclusion of fillers, and independent Claim 18 provides a method for making same.

In contrast to the claimed invention, each of the references cited by the Patent Office fails to disclose a chewing gum specifically requiring the simultaneous absence of fillers and the inclusion of lecithin. Therefore, Appellants respectfully submit that the anticipation rejection of Claims 1-6 and 14-20 is at odds with the law and facts.

The references cited by the Patent Office disclose gum products that merely include fillers and/or lecithin as optional ingredients. For example, *Cherukuri 003* discloses that fillers may be added if desired and emulsifiers, such as lecithin, may be optionally used. *See, Cherukuri 003*, column 2, line 50-57; column 6, lines 34-36. The *D'Amelia* reference, like *Cherukuri 003*, discloses that the use of a filler and/or emulsifier (lecithin) is optional. *See, D'Amelia Abstract*. At most, *Cherukuri 615* discloses that the use of a filler within chewing gum is optional. In its Abstract, *Cherukuri 615* discloses that the chewing gum base composition includes fillers.

In contrast to the above-cited references, the use of lecithin and the non-use of a filler are not optional components of the claimed invention. More specifically, the present invention requires that the chewing gum include lecithin but no filler. These requirements of the present invention are the result of Appellants' unexpected finding that such gum formulations can provide reduced adhesion to environmental surfaces. In this regard, if either of these features of the claimed invention were disregarded, it is believed that the resulting gum product may not display the reduced adhesion characteristics of the present invention. Because the cited references disclose formulations of gums

that can be devoid of lecithin and inclusive of fillers, Appellants believe that one skilled in the art would not consider the gum products of the cited references to provide a chewing gum with reduced-adhesion features as required by the claimed invention. Indeed, nowhere does *Cherukuri 003*, *D'Amelia* or *Cherukuri 615* recognize that a gum expressly containing lecithin but not a filler can reduce the adhesive properties of the gum, particularly after the gum has been chewed.

This distinction between the claimed invention and the cited references is important. It clearly demonstrates that the inventors in those references did not appreciate the connection between the absence of fillers and a gum that possesses reduced-adhesion properties. In *Cherukuri 615*, for example, wherein the inclusion of fillers is optional, it is clear that the inventors believed that the only benefit of reducing filler content is a gum product that is more flavorful. In this regard, *Cherukuri 615* provides in pertinent part:

The use of such fillers however limits the amount of flavor agent that can be added and therefore lessens the perceived breath freshening quality of the chewing gum.

*Cherukuri 615, col. 5, lines 62-65.*

In addition to not appreciating the ramifications of the absence of fillers in chewing gum, the cited references likewise indicate no appreciation for the necessity of including large amounts of lecithin in order to achieve a reduced-adhesion chewing gum. In contrast, the following passage from Appellants' patent application demonstrates Appellants' understanding of the scientific principles underlying their invention, most notably the rationale for the inclusion of high levels of lecithin and the absence of fillers:

It has been found that by eliminating these fillers from gum bases and adding high levels of lecithin, that the resultant chewing gum, when chewed, will produce gum cuds having reduced adhesion to environmental surfaces. It is believed that eliminating the filler from the gum base prevents the fillers from mixing with the active elements of the gum base (e.g., polymers, softeners, and flavors) causing a decrease in gum cud removal times. The addition of lecithin, especially at high

levels, is believed to act as a partitioning agent between high molecular weight materials. Due to the absences of filler materials, the polar end of lecithin remains free while the non-polar end of the lecithin remains attached to the high molecular weight materials. This results in a solid, but looser matrix of gum components. This matrix affords improved removability from surfaces characteristic to the gum cud.

*Specification*, page 5, lines 4-15.

As noted above, the cited references clearly fail to recognize that reduced adhesion to any surface results specifically from the exclusion of fillers and the inclusion of lecithin. Indeed, *Cherukuri 003*, *D'Amelia* and *Cherukuri 615* have provided no experimental examples disclosing a gum product that excludes fillers and includes lecithin, let alone experimental results demonstrating that a gum product with such features can display reduced-adhesion properties, particularly with respect to environmental surfaces as required by the claimed invention.

Based on the fact that each of the cited references fails to disclose a chewing gum that specifically includes lecithin and that does not include fillers, let alone such chewing gum that can reduce adhesion to environmental surfaces as required by the claimed invention, Appellants respectfully submit that the references fail to anticipate Claims 1-6 and 14-20.

3. The Rejection of Claims 8-13 under 35 U.S.C. § 103(a) Should Be Reversed Because the Patent Office Has Failed to Overcome its *Prima Facie* Burden

Appellants respectfully submit that that the rejection of Claims 8-13 under 35 U.S.C. § 103(a) should be reversed based on the fact that the Patent Office has failed to establish a *prima facie* case of obviousness. The Patent Office has relied on *Cherukuri 615*, *Cherukuri 003* or *D'Amelia* to support its obviousness rejection.

Independent Claim 8 of the present invention recites a chewing gum composition that includes an elastomer, at least 20% by weight lecithin, and no filler. In contrast, the clear focus of

the cited references is to provide for the optional inclusion of an emulsifier, such as lecithin, in amounts that are considerably less than 20%. More specifically, a maximum of 10% emulsifier content is taught by *Cherukuri 115*, *Cherukuri 003* and *D'Amelia*. The basis of the Patent Office's obviousness rejection of Claims 8-13 is that it would have been merely a matter of routine experimentation by one skilled in the art to include an optimum amount of lecithin.

Appellants respectfully remind the Patent Office that the cited references in no way teach that increasing emulsifier content can result in a reduced-adhesion gum. In fact, as discussed previously, the cited references clearly fail to recognize the importance of the interplay between the exclusion of fillers and the inclusion of lecithin, let alone higher levels of lecithin, in gums to reduce adhesion properties, particularly with respect to environmental surfaces as required by the claimed invention.

For example, *Cherukuri 115* states that the only benefit of reducing filler content is a chewing gum that provides for more flavorful taste. More specifically, *Cherukuri 115* notes that fillers lessen the perceived breath-freshening properties of the chewing gum. Moreover, the other cited references, wherein fillers are optional, fail to disclose or suggest that the exclusion of fillers can contribute to the reduced adhesion of a gum product, let alone reduced adhesion to environmental surfaces as previously discussed.

In contrast, Appellants have discovered that the simultaneous exclusion of fillers and inclusion of lecithin result in a gum product that displays reduced adhesion, especially to environmental surfaces. As previously discussed, Appellants have provided a detailed explanation why a gum with lecithin and without fillers should have reduced adhesion properties. Moreover,

Appellants have conducted experimental studies that clearly demonstrate the beneficial effects of the claimed invention.

In this regard, on pages 11-14 of the instant patent application, experimental gum compositions are discussed. Comparative Example 4 is an example of a conventional chewing gum that contains fillers but contains no lecithin. Examples 5-9 are chewing gum compositions made pursuant to an embodiment of the claimed invention.

The experimental gum compositions were each subject to an adhesion test. As compared to Comparative Example 4, the Inventive Examples 5-9 displayed approximately 40% to 50% reduced adhesion to environmental surfaces. Therefore, Appellants do not believe that one skilled in the art viewing the references, separately or even if combinable, would be inclined to modify the references to provide a gum with lecithin without fillers and with reduced adhesion properties as required by the claimed invention.

What the Patent Office has clearly done is to apply hindsight reasoning to arrive at the claimed invention. Of course, this is not the correct standard of patentability. “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”

*W.L. Gore & Associates, Inc. v. Garlack, Inc.*, 220 U.S.P.Q. 303,312-4 (Fed. Cir. 1983).

As previously discussed, the cited references are clearly deficient with respect to a number of features of the claimed invention. In particular, Appellants believe that the cited references fail to teach or suggest a gum product that includes lecithin, such as at high levels of at least 20% by

weight, and without fillers to provide reduced adhesion properties, particularly with respect to environmental surfaces as required by the claimed invention.

If the claimed invention was so obvious in view of the cited art, why do the cited references merely disclose that lecithin and fillers are optional ingredients; why do the cited references merely disclose an optimum level of 10% by weight of lecithin for gum formulations; and why do the cited references fail to recognize the importance that the interplay between lecithin without fillers has on reducing adhesion properties of a gum, particularly with respect to environmental surfaces. As previously discussed, Appellants have conducted comparative tests to demonstrate the reduced effect that lecithin without fillers has on the adhesion characteristics of gum. Therefore, Appellants believe that the Patent Office has clearly failed to establish a *prima facie* case of obviousness. Even if the Patent Office has met its burden, Appellants have clearly demonstrated unexpected results rebutting same.

Accordingly, Appellants respectfully submit that the claimed invention is clearly patentable over the cited references, even if combinable.

4. The Rejection of Claim 7 under 35 U.S.C. § 103(a) Should Be Reversed Because the Patent Office Has Failed to Overcome its *Prima Facie* Burden

---

Appellants respectfully submit that the rejection of Claim 7 under 35 U.S.C. § 103(a) should be reversed based on the fact that the Patent Office has failed to establish a *prima facie* case of obviousness. The Patent Office relies on *Klose* to remedy the deficiencies of *Cherukuri 615*, *Cherukuri 003* and *D'Amelia*, particularly the deficiencies with respect to the antioxidant and colorant features of Claim 7.

Appellants submit that this rejection is improper. Claim 7 depends from independent Claim 1 and therefore as a matter of law incorporates each feature of independent Claim 1. As previously discussed, *Cherukuri 615*, *Cherukuri 003* and *D'Amelia* each fail to teach or suggest a number of features, such as the simultaneous inclusion of lecithin and exclusion of filler, as required by independent Claim 1. Further, *Klose* cannot remedy the deficiencies of these references. The Patent Office merely relies on *Klose* for its teaching regarding antioxidants and colorants.

Based on the fact that the cited references fail to teach or suggest a number of features of Claim 7, Appellants submit that these references, alone or in combination, fail to render obvious Claim 7. Accordingly, Appellants respectfully request that this rejection be reversed.

#### IX. CONCLUSION

Appellants submit that the Patent Office has failed to overcome its *prima facie* burden with respect to the rejections of Claims 1-6 and 14-20 under 35 U.S.C. § 102(b), Claims 8-13 under 35 U.S.C. § 103(a), and Claim 7 under 35 U.S.C. § 103(a). Accordingly, Appellants respectfully submit that the rejections of the pending claims are erroneous in law and in fact and should therefore be reversed by this Board.

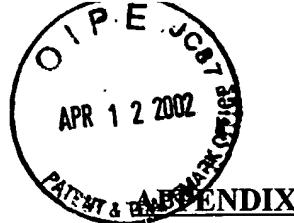
Respectfully submitted,



(30,142)

Robert M. Barrett  
BELL, BOYD & LLOYD LLC  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
Telephone: (312) 807-4204

ATTORNEYS FOR APPELLANTS



1. A chewing gum comprising:

a water insoluble portion not including a filler;

a water soluble portion including a flavor; and

5 approximately 3% to about 15% by weight lecithin.

1. The chewing gum of Claim 1 including:

an elastomer comprising approximately 3% to about 50% by weight of the water insoluble

portion;

10 a softener comprising approximately 3% to about 50% by weight of the water insoluble

portion; and

an emulsifier comprising approximately 2% to about 20% by weight of the water insoluble portion.

15 3. The chewing gum of Claim 1 including an elastomer solvent.

4. The chewing gum of Claim 1 including a resin.

5. The chewing gum of Claim 4 wherein the resin is chosen from the group consisting

20 of polyvinylacetate, vinylacetate-vinylaurate copolymer, ethylenevinylacetate and polyvinyl alcohol.

6. The chewing gum of Claim 4 wherein the resin comprises approximately 5% to about 75% by weight of the insoluble portion.

25 7. The chewing gum of Claim 1 including:

a color; and

an antioxidant.

8. A gum base comprising:

5 an elastomer;

at least 20% by weight lecithin; and

no filler.

9. The gum base of Claim 8 wherein:

10 the elastomer comprises approximately 3% to about 50% by weight of the gum base.

10. The gum base of Claim 8 including softener that comprises approximately 3% to about 50% by weight of the gum base.

15 11. The gum base of Claim 8 including an emulsifier that comprises approximately 2%

to about 20% by weight of the gum base.

12. The gum base of Claim 8 including resin that comprises approximately 5% to about 75% by weight of the gum base.

20 13. The gum base of Claim 8 including elastomer solvent that comprises approximately

3% to about 70% by weight of the gum base.

14. A chewing gum comprising:

25 a water soluble portion including a flavor;

a water insoluble gum base portion that does not include a filler; and

at least 5% by weight lecithin.

15. The chewing gum of Claim 14 wherein the chewing gum is sugar free.

5 16. The chewing gum of Claim 14 wherein the water insoluble gum base portion  
includes:

an elastomer;

a softener;

a resin;

10 an emulsifier; and

an elastomer solvent.

17. The chewing gum of Claim 14 wherein:

the elastomer comprises approximately 3% to about 50% by weight of the water insoluble

15 gum base portion;

the softener comprises approximately 3% to about 50% by weight of the water insoluble gum

base portion;

the emulsifier comprises approximately 2% to about 20% by weight to the water insoluble

gum base portion;

20 the resin comprises approximately 5% to about 75% by weight of the water insoluble gum

base portion; and

the elastomer solvent comprises approximately 3% to about 70% by weight of the water insoluble gum base portion.

18. A method for producing chewing gum wherein a resultant gum cud that is produced  
5 has reduced adhesion to environmental surfaces as compared to a gum cud produced by typical chewing gum formulations comprising the steps of using a gum base to produce the chewing gum that does not include a filler and adding at least 3% by weight lecithin to the chewing gum.

19. The method of Claim 18 wherein the lecithin is added to the gum base.

10

20. The method of Claim 18 further comprising using a water soluble portion wherein the lecithin is added to the water soluble portion.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MC

APPLICATION NUMBER      FILING DATE      FIRST NAMED APPLICANT      ATTORNEY DOCKET NO.

EXAMINER

ART UNIT      PAPER NUMBER

DATE MAILED: 11

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

**ADVISORY ACTION**

THE PERIOD FOR REPLY:

a)  will expire 3 months from the date of the final Office action (including extensions of time granted).  
b)  expires either (1) three months from the mail date of the final Office action, or (2) on the mail date of this Advisory Action, whichever is later. In no event, however, will the statutory period for reply expire later than six months from the mail date of the final Office action.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above.

Appellant's Brief is due in accordance with 37 CFR 1.192(a).  
 Applicant's reply to the final rejection, filed 1-7-02 has been considered with the following effect, but it is not deemed to place the application in condition for allowance.  
1.  The proposed amendment to the claim and/or specifications will not be entered and the final rejection stands because:  
a.  There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.  
b.  They raise new issues that would require further consideration and/or search. (See Note).  
c.  They raise the issue of new matter. (See Note).  
d.  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.  
e.  They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2.  Newly proposed or amended claim \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.  
3.  Upon the filing an appeal, the proposed amendment  will be entered  will not be entered and the status of the claims will be as follows:

Claim allowed: None

Claims objected to: None

Claims rejected: 1-20

However:

Applicant's reply has overcome the following rejection(s): \_\_\_\_\_

4.  The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because \_\_\_\_\_  
*of the reasons set forth in paragraph no. 9, page No. 9.*

5.  The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.  
 The proposed drawing correction  has  has not been approved by the examiner.  
 Other \_\_\_\_\_

Applicant may obtain further examination by filing a request for an application under 37 CFR 1.53(d) (CPA).

ARTHUR L. CORBIN  
PRIMARY EXAMINER

1-1-02



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/648,033	08/25/00	PATEL	112703-017

IM52/1011

EXAMINER

DORRITN. A

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 10/11/01

DUE: 1-11-02

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**RECEIVED**  
BELL, BOYD & LLOYD  
INTELLECTUAL PROPERTY DOCKET

OCT 22 2001 TK

ATTY: RMB

DOCKET #: 112703-017

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/648,123	PATEL ET AL
Examiner	Group Art Unit	
ARTHUR L. CARSON	1761	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

Responsive to communication(s) filed on 8-3-01. DUE 11/11/02

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s) 1-2-0 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-2-0 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

Art Unit: 1761

### DETAILED ACTION

1. Claim 2 is objected to because of the following informalities: In claim 2, 4 and 6, "comprises" should be changed to "comprising". Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 14-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cherukuri et al (4,518,615, cols. 5 and 6 and Table III, Run D), Cherukuri et al. (4,794,004, cols. 2, 6, 7 and 8) or D'Amelia et al (cols 3, 5, 6 and 10). Applicant is referred to paragraph no. 5, Paper No. 5.

5. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al. (4,518,615), Cherukuri et al (4,794,003) or D'Amelia et al. Applicant is referred to paragraph no. 6, Paper No. 5..

Art Unit: 1761

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al (4,518,615), Cherukuri et al. (4,794,003) or D' Amelia et al in view of Klose et al. Applicant is referred to paragraph no. 7, Paper No. 5.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

8. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 09/648,028 in view of either Cherukuri et al patent or D'Amelia et al. Applicant is referred to paragraph no. 9, Paper No.5

9. Applicant's arguments filed August 6, 2001 have been fully considered but they are not persuasive. Applicant's comments with regard to each primary reference are without merit. Cherukuri et al ('003) clearly recites "without the use of a filler" (col. 2, line 56) and includes lecithin (col. 6). Cherukuri et al ('615) clearly suggests a gum base absent a filler Table III, Run D) and requires the use of an emulsifier, e.g., lecithin (col. 5, lines 1-2). D'Amelia et al discloses

Art Unit: 1761

“0% filler” (col. 5, lines 38-39 and col. 10, line 61) and the use of lecithin (col. 6, lines 20-25).

The disclosure in each of these patents that the use of a filler is optional does not detract from their teaching that a gum base without a filler but including lecithin is known in the art.

Additionally, the chewing gum prepared in each primary reference will inherently achieve applicant’s result of reduced adhesion to environmental surfaces since applicant’s claimed gum composition is disclosed by each primary reference.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can normally be reached on Tuesday-Friday from 9:30 a.m. to 7:00 p.m. The examiner can also be reached on alternate Mondays.

Art Unit: 1761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A. Corbin/dh

October 9, 2001

ARTHUR L. CORBIN  
PRIMARY EXAMINER

10-10-01